

REMARKS

Applicants respectfully request reconsideration and allowance of all pending claims.

I. Status of Pending Claims

Claims 1-14 and 18-41 remain pending in the present application. Claims 15-17 have been canceled.

II. Elections/Restrictions

Applicants have canceled the Group II claims 15-17 to comply with the restriction requirement with respect to these claims.

Reconsideration is requested of the restriction requirement and the assertion that the invention of the Group I claims 1-14 and 18-35 and the invention of Group III claims 36-41 are distinct.

The basis for the restriction requirement on pages 2 and 3 of the Office action dated September 27, 2005 is the following assertion:

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h)). In the instance case the product claimed can be used to cure an adhesive ball.

Applicants respectfully submit that this basis is not sufficient to support a conclusion that the invention of the Group I and the invention of Group III claims are distinct. Applicants' fluxing curative as defined in Group I is specifically stated to be for "...curing an underfill that comprises an epoxy resin and for *fluxing a solder* during a solder assembly of an electronic component to an

electronic device substrate..." The process of using the fluxing curative of the Group I claims is not a materially different process from the process cited by the Office, "...to cure an adhesive ball." A solder flux comprising the fluxing curative of the Group I claims can be applied to solder bumps, which are often formed on metal pads of a substrate as a solder bump, i.e., having a shape very similar to the ball cited by the Office. Accordingly, the fluxing curative can be applied to a "ball," such as a solder bump, which is used to attach or adhere a device to a substrate. Because the adhesive ball cited by the Office is not materially different from a solder bump, the process cited by the Office is not a materially different process from the process of the Group III claims. Accordingly, the Office has failed to provide an example of "...a materially different process of using that product..." as required by MPEP 806.05(h) to support the restriction requirement. Applicants respectfully request that the Office withdraw the restriction requirement of the Groups I and III claims.

Withdrawal of the restriction requirement is also requested on the basis of the following instruction from MPEP 803:

If the search and examination can be made without serious burden, the examiner **must** examine it on the merits, even if it includes claims to distinct or independent inventions.  
MPEP 803 (emphasis added)

In this regard, applicants respectfully ask the Office to consider the relative burdens on itself and the applicants, as well as the similar nature of these claims, as directed by MPEP 803. The process and composition claims were intentionally drafted to closely mirror each other and to capture the same inventive concepts. In order for a reliable search to be conducted for either the applicants' composition or process claims, both Class/subclass combinations will have to be

searched. Accordingly, maintaining all claims in the application should not add more than a minimal burden.

The applicants further emphasize that the Office routinely examines both composition and process claims in the same application in situations such as this. Recently issued patents with claims directly analogous to applicants' claims include the following:

6,562,221 (May 2003)

PROCESS AND COMPOSITION FOR HIGH SPEED PLATING OF TIN AND TIN ALLOYS

Claim 1. A composition for electroplating tin or tin alloys onto a substrate said composition comprising..."

Claim 7. A process for electroplating tin or tin alloys onto a substrate comprising contacting the substrate..."

6,689,738 (Feb. 2004)

OXIDATION PROCESS AND COMPOSITION

Claim 1. Oxidation process wherein an oxidisable substance is reacted with..."

Claim 9. A composition for oxidizing substances, comprising..."

6,620,263 (Sept. 2003)

ZINC PHOSPHATE PROCESS AND COMPOSITION WITH REDUCED POLLUTION POTENTIAL

Claim 1. An aqueous liquid working composition for forming phosphate conversion coating on a metal surface..."

Claim 19. A process for forming a phosphate conversion coating on a metal substrate..."

6,638,370 (Oct. 2003)

PHOSPHATE CONVERSION COATING PROCESS AND COMPOSITION

Claim 1. An aqueous liquid composition of matter that will form a conversion coating by..."

Claim 6. A process for forming a conversion coating on a ferriferous substrate by..."

Claim 17. A process for bonding a ferriferous substrate..."

6,663,467 (Dec. 2003)

PROCESS AND COMPOSITION FOR ABRADING PRE-FINISHED SURFACES

Claim 1. An abrading composition for abrading surface coverings comprising..."

Claim 9. A process for abrading a wood floor surface comprising..."

These are not isolated instances, as the patent collection is replete with such patents. While this is not controlling on the Office in the present case, applicants respectfully request that it be taken into account when weighing i) the relative burdens, ii) the closely parallel nature of applicants' composition and process claims, and iii) the overlapping if not identical nature of the respective searches required.

The applicants respectfully submit that the burden of examining the additional composition claims having overlapping search fields cannot fairly be said to be "serious." In contrast, applicants would incur filing fees of about \$1000.00, issue fees of about \$1400.00, and maintenance fees of about \$7000.00 or more if required to prosecute and maintain a second application/patent, such fees being in addition to the similar fees to be incurred in this first application.

In view of the foregoing, applicants respectfully ask the Office to withdraw the restriction requirement. Applicants hereby elect to prosecute the Group I claims, if the restriction requirement is not withdrawn.

CONCLUSION

In view of the foregoing, applicants respectfully request allowance of claims 1-14 and 18-41.

It is believed that no fees are due in connection with this response. If, however, the Commissioner determines that fees are required, he is authorized to charge Deposit Account No. 19-1345.

Respectfully submitted,



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